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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,085	02/06/2004	James F. Macier	1058742	2084

27062 7590 12/21/2006
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EXAMINER

VASUDEVA, AJAY

ART UNIT	PAPER NUMBER
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3617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/708,085	Applicant(s) MACIER ET AL.	
	Examiner Ajay Vasudeva	Art Unit 3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-33 and 41-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-33 and 41-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 18, 19, 22-29, 41-47, 49-51 and 53 are rejected under 35 U.S.C. 102(b) as being anticipated by Herrera (US 6,358,106 B1).

Herrera shows an outboard motor (fig. 5) having an engine [8], an engine cover [14], and first and second lower/midsection covers [22, 24]. At least three silencers [44] are disposed in the volume defined between the engine and the covers so as to substantially match the contour of the respective cover (fig. 5 and fig. 6; col. 3-4).

The first and third silencers attached to the lower covers have a density that is greater than the density of the second silencer attached to the upper cover. As such, the first and third silencers are considered to be more waterproof than the second silencer.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 20, 21, 30-33, 48, 52, 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrera (US 6,358,106 B1).

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Herrera shows an outboard motor with a 250 hp engine, as above, with the lower silencers having a density of two pounds per cubic foot, and the upper silencer having a density of one pound per cubic foot (col. 4, lines 41-53). However, Herrera does not specifically disclose the lower silencers having a density of approximately twenty-two pounds per cubic foot, and the upper silencer having a density of at least four pound per cubic foot (claims 20, 21, 30-33, 48, 52, 54).

Further, Herrera does not show the motor emitting a certain decibel at a specific rpm (claims 30-33).

The Examiner notes that for higher capacity engines emitting louder noise, the claimed density selection for the respective silencers is considered to be an obvious design choice. It would have been obvious for an artisan to make the silencers with substantially higher density, such as with a density in the range of approximately twenty-two pounds per cubic foot. Choosing such density would have been desirable because it would have provided maximum noise reduction without adding too much weight to the outboard motor or without adversely affecting the engine performance.

Regarding the level of noise produced by the motor at a specific rpm, it is noted that such is a function of diverse factors – such as the age and maintenance condition of the engine, the gear/transmission ratio, the load on the engine, the fuel and lubricant used, the condition of the air intake and exhaust systems, the atmospheric temperature condition at the time of engine startup or running etc. Therefore, it would have been inherent for the engine to emit a noise corresponding to the specific rpm, as being claimed, for a certain combination of such diverse factors.

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Response to Arguments

5. In view of Applicant's affidavit submitted under 37 CFR §1.131, the rejection under 35 U.S.C. 102(e) based on Wolaver has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Herrera (US 6,358,106 B1).

Conclusion

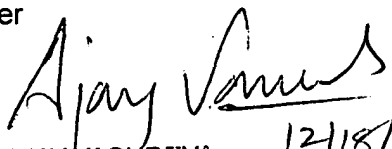
6. The prior art made of record in the attached PTO Form 892, but not yet relied upon, is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay Vasudeva whose telephone number is (571) 272-6689. The examiner can normally be reached on Monday-Friday 12:00 -- 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Joe Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ajay Vasudeva
Primary Examiner
Art Unit 3617


AJAY VASUDEVA
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600
12/18/06